

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79074557
LAW OFFICE ASSIGNED	LAW OFFICE 102
MARK SECTION (no change)	
ARGUMENT(S)	<p>Likelihood of Confusion</p> <p>The Examiner continues to cite Registration Nos. 2145559, 1457422 and 2124713 as blocking this application due to a likelihood of confusion. The applicant has now amended its identification of goods and services to further avoid any likelihood of confusion.</p> <p>The applicant notes that although the marks are similar, the applicant's mark features a distinctive design that will serve to alert consumers of a different source from the registered marks. In addition, the goods on which they are used are different and do not commonly come from the same source. The registered mark is used for goods in classes 3, 8, 9, 14, 16, 18, and 25. By contrast, the applicant's amended identification of goods claims goods in classes 14, 21, 26 and 44. Only the class 14 goods are claimed by both parties, and the applicant has specifically excluded the registrant's goods from its class 14 identification. These are very different products aimed at different consumers.</p> <p>The differences in the products are shown by the fact that the Nice classification system adopted by the USPTO classifies them in different classes. The applicant's goods include housewares and embroidery, cufflinks and hair bands while the registrant claims hair care products and clothing, purses and belts.</p> <p>The combination of the differences in the goods and the marks assures that there will be no likelihood of confusion as to the source of the Applicant's goods. Accordingly, the refusal to register under Section 2(d) should be withdrawn.</p>
GOODS AND/OR SERVICES SECTION (014)(current)	
INTERNATIONAL CLASS	014
DESCRIPTION	

Jewelry, fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, tie pins, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry

GOODS AND/OR SERVICES SECTION (014)(proposed)

INTERNATIONAL CLASS

014

TRACKED TEXT DESCRIPTION

Jewelry, fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, tie pins, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry; Jewelry excluding timers, watches and alarm clocks; fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry

FINAL DESCRIPTION

Jewelry excluding timers, watches and alarm clocks; fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry

GOODS AND/OR SERVICES SECTION (021)(current)

INTERNATIONAL CLASS

021

DESCRIPTION

Containers for household or kitchen use, combs, hair brushes, brush-making materials, steel wool, unworked or semi-worked glass except glass used in building; works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, powder and make-up puffs, basins in the nature of receptacles, shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, powder compacts, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges

GOODS AND/OR SERVICES SECTION (021)(proposed)

INTERNATIONAL CLASS

021

TRACKED TEXT DESCRIPTION

Containers for household or kitchen use, combs, hair brushes, brush-making materials, steel wool, unworked or semi-worked glass except glass used in building; works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, powder and make-up puffs, basins in the nature of receptacles,

~~shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, powder compacts, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges; works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, basins in the nature of receptacles, shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges~~

FINAL DESCRIPTION

Containers for household or kitchen use, combs, hair brushes, brush-making materials, steel wool, unworked or semi-worked glass except glass used in building; works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, basins in the nature of receptacles, shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges

GOODS AND/OR SERVICES SECTION (026)(current)

INTERNATIONAL CLASS

026

DESCRIPTION

Lace and embroidery, ribbons and braid, buttons, hooks and eyes, bobby pins, needles, artificial flowers, shoe fasteners, ornamental novelty badges, hair bands, false beards, barrettes and hair-slides, hair curlers, pins for hair curlers, edgings for clothing, buckles, shoe buckles, brooches, belt clasps, hat ornaments not made of precious metal, shoe ornaments not of precious metal, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons, ornamental hair pins, fasteners for clothing, false mustaches, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair, hair curling papers

GOODS AND/OR SERVICES SECTION (026)(proposed)

INTERNATIONAL CLASS

026

TRACKED TEXT DESCRIPTION

~~Lace and embroidery, ribbons and braid, buttons, hooks and eyes, bobby pins, needles, artificial flowers, shoe fasteners, ornamental novelty badges, hair bands, false beards, barrettes and hair-slides, hair curlers, pins for hair curlers, edgings for clothing, buckles, shoe buckles, brooches, belt clasps, hat ornaments not made of precious metal, shoe ornaments not of precious metal, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons, ornamental hair pins, fasteners for clothing, false mustaches, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair, hair curling papers;~~
Lace and embroidery, ribbons and braid, artificial flowers, ornamental novelty badges, hair bands, barrettes and hair-slides, hair curlers, pins for hair curlers, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons, ornamental hair pins, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair

FINAL DESCRIPTION

Lace and embroidery, ribbons and braid, artificial flowers, ornamental novelty badges, hair bands, barrettes and hair-slides, hair curlers, pins for hair curlers, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons, ornamental hair pins, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair

GOODS AND/OR SERVICES SECTION (044)(current)**INTERNATIONAL CLASS**

044

DESCRIPTION

Hygiene and beauty care for humans, aromatherapy services, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, sauna services, solarium services, visagists' services in the nature of services of a make-up artist

GOODS AND/OR SERVICES SECTION (044)(proposed)**INTERNATIONAL CLASS**

044

TRACKED TEXT DESCRIPTION

~~Hygiene and beauty care for humans, aromatherapy services, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, sauna services, solarium services, visagists' services in the nature of services of a make-up artist;~~ Hygiene and beauty care for humans, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, visagists' services in the nature of services of a make-up artist

FINAL DESCRIPTION

Hygiene and beauty care for humans, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, visagists' services in the nature of services of a make-up artist

SIGNATURE SECTION**RESPONSE SIGNATURE**

/ft/

SIGNATORY'S NAME

Frank Terranella

SIGNATORY'S POSITION

Attorney for applicant, NY Bar Member

DATE SIGNED

06/01/2011

AUTHORIZED SIGNATORY

YES

CONCURRENT APPEAL NOTICE FILED

YES

FILING INFORMATION SECTION**SUBMIT DATE**

Wed Jun 01 09:32:30 EDT 2011

TEAS STAMP

USPTO/RFR-216.75.92.26-20
110601093230640120-790745
57-48045cff129cc7f8fc2ca9
97d2017abf052-N/A-N/A-201
10601092639159326

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **79074557** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

Likelihood of Confusion

The Examiner continues to cite Registration Nos. 2145559, 1457422 and 2124713 as blocking this application due to a likelihood of confusion. The applicant has now amended its identification of goods and services to further avoid any likelihood of confusion.

The applicant notes that although the marks are similar, the applicant's mark features a distinctive design that will serve to alert consumers of a different source from the registered marks. In addition, the goods on which they are used are different and do not commonly come from the same source. The registered mark is used for goods in classes 3, 8, 9, 14, 16, 18, and 25. By contrast, the applicant's amended identification of goods claims goods in classes 14, 21, 26 and 44. Only the class 14 goods are claimed by both parties, and the applicant has specifically excluded the registrant's goods from its class 14 identification. These are very different products aimed at different consumers.

The differences in the products are shown by the fact that the Nice classification system adopted by the USPTO classifies them in different classes. The applicant's goods include housewares and embroidery, cufflinks and hair bands while the registrant claims hair care products and clothing, purses and belts.

The combination of the differences in the goods and the marks assures that there will be no likelihood of confusion as to the source of the Applicant's goods. Accordingly, the refusal to register under Section 2(d) should be withdrawn.

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 014 for Jewelry, fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, tie pins, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Jewelry, fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, tie pins, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry;~~ Jewelry excluding timers, watches and alarm clocks; fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry

Class 014 for Jewelry excluding timers, watches and alarm clocks; fashion jewelry, works of art of precious metal, jewelry cases, boxes of precious metal, cuff links, tie pins, tie-bars, ornamental pins, figurines and statuettes of precious metal, badges of precious metal, medals, hat ornaments of precious metal, ornaments made of precious metal, earrings, gems, semi-precious stones, precious stones, statues of precious metal, statuettes of precious metal, paste jewelry

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 021 for Containers for household or kitchen use, combs, hair brushes, brush-making materials, steel wool, unworked or semi-worked glass except glass used in building; works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, powder and make-up puffs, basins in the nature of receptacles, shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, powder compacts, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: Containers for household or kitchen use, combs, hair brushes, brush-making materials, steel wool, unworked or semi-worked glass except glass used in building; ~~works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, powder and make-up puffs, basins in the nature of receptacles, shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing~~

~~the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, powder compacts, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges; works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, basins in the nature of receptacles, shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges~~

Class 021 for Containers for household or kitchen use, combs, hair brushes, brush-making materials, steel wool, unworked or semi-worked glass except glass used in building; works of art of porcelain, terra-cotta or glass, brooms, buckets, shaving brushes, basins in the nature of receptacles, shaving brush stands, glass jars, jugs, toothbrushes, electric toothbrushes, electric hair brushes without a heating aspect, perfume burners, soap dispensers, abrasive sponges for scrubbing the skin, toilet sponges, sponge holders, comb cases, floss for dental purposes, flasks, cups, scouring pads, nail brushes, electric hair combs, soap holders, towel-rails, drinking vessels, soap dispensers, eyebrow brushes, toilet brushes, toilet sponges

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 026 for Lace and embroidery, ribbons and braid, buttons, hooks and eyes, bobby pins, needles, artificial flowers, shoe fasteners, ornamental novelty badges, hair bands, false beards, barrettes and hair-slides, hair curlers, pins for hair curlers, edgings for clothing, buckles, shoe buckles, brooches, belt clasps, hat ornaments not made of precious metal, shoe ornaments not of precious metal, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons, ornamental hair pins, fasteners for clothing, false mustaches, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair, hair curling papers
Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Lace and embroidery, ribbons and braid, buttons, hooks and eyes, bobby pins, needles, artificial flowers, shoe fasteners, ornamental novelty badges, hair bands, false beards, barrettes and hair-slides, hair curlers, pins for hair curlers, edgings for clothing, buckles, shoe buckles, brooches, belt clasps, hat ornaments not made of precious metal, shoe ornaments not of precious metal, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons, ornamental hair pins, fasteners for clothing, false mustaches, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair, hair curling papers;~~
Lace and embroidery, ribbons and braid, artificial flowers, ornamental novelty badges, hair bands, barrettes and hair-slides, hair curlers, pins for hair curlers, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons, ornamental hair pins, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair

Class 026 for Lace and embroidery, ribbons and braid, artificial flowers, ornamental novelty badges, hair bands, barrettes and hair-slides, hair curlers, pins for hair curlers, hair pins, hair curling pins, hair nets, plaited hair, hair grips and slides, hair clips, false hair, tresses of hair, hair ornaments, elastic ribbons,

ornamental hair pins, birds' feathers for ornamentation, wigs, feathers for ornamentation, headbands, braids, bows for hair

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 044 for Hygiene and beauty care for humans, aromatherapy services, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, sauna services, solarium services, visagists' services in the nature of services of a make-up artist

Original Filing Basis:

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

Proposed:

Tracked Text Description: ~~Hygiene and beauty care for humans, aromatherapy services, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, sauna services, solarium services, visagists' services in the nature of services of a make-up artist;~~ Hygiene and beauty care for humans, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, visagists' services in the nature of services of a make-up artist

Class 044 for Hygiene and beauty care for humans, hairdressing salons, hairdressing services, hair implantation, manicuring, massage, hairdressing salons, visagists' services in the nature of services of a make-up artist

Filing Basis Section 66(a), Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /ft/ Date: 06/01/2011

Signatory's Name: Frank Terranella

Signatory's Position: Attorney for applicant, NY Bar Member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79074557

Internet Transmission Date: Wed Jun 01 09:32:30 EDT 2011

TEAS Stamp: USPTO/RFR-216.75.92.26-20110601093230640
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